

This action is in response to applicants' amendment of 30 November 2009. Applicant's arguments have been fully considered with respect to the art rejection but they are not persuasive.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 6-25 of copending Application No. 10/574,663. Although the conflicting claims are not identical, they are not patentably distinct from each other because the composition printed onto the claimed document and the claimed document in Application No. 10/574,663 suggest the coding composition and value document claimed in this application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 1-16 and 18-28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3-10 and 12-25 of copending Application No. 10/574,662. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed coding system and the claimed document in Application No. 10/574,662 suggest the coding composition and value document claimed in this application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicants' comment with respect to the filing of a terminal disclaimer is noted. It does not overcome the above rejections.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 10 and 12-19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. patent 6,380,547.

This reference teaches an composition for securing, by tagging, value documents, such as currency or books. Column 7, lines 50-59 teaches that the composition can contain a plurality of luminescent dyes which emit outside the visible wavelength range, such as in the range of 700-1200 nm (col. 5, lines 50-56). The preferred number of dyes is at least three and even more preferable is at least five dyes (col. 8, lines 11-16) and figure 1 teaches five luminescent dyes that have an emission peaks or lines in the range 700-960 nm, which is outside the visible spectra range. These dyes include two pair of dyes that have overlapping emission ranges and the overlapping emission range of each pair does not overlap the other. Figure 1 shows dyes which

emitting the range of 700-1000 nm and pairs which emit in the overlapping ranges of about 760-800 nm, about 810-820 nm 890-930 nm. These overlapping range widths fall within that of claims 10 and 12. The reference teaches the claimed system and method of using the system.

Claims 2, 11 and 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. patent 6,380,547.

As stated above, this reference teaches the claimed composition. Figure 1 shows dyes which emitting the range of 700-1000 nm and pairs which emit in the overlapping ranges of about 760-800 nm, about 810-820 nm 890-930 nm. The taught joint emission range and overlapping ranges overlap the ranges of claims 2, 11 and 20-22. Product claims with numerical ranges which overlap prior art ranges were held to have been obvious under 35 USC 103. *In re Wertheim* 191 USPQ 90 (CCPA 1976); *In re Malagari* 182 USPQ 549 (CCPA 1974); *In re Fields* 134 USPQ 242 (CCPA 1962); *In re Nehrenberg* 126 USPQ 383 (CCPA 1960). Also see MPEP 2144.05. The reference suggests the claimed composition.

Applicants' arguments have been considered but are not convincing since the reference does teach compositions where the luminophors, which are luminescent substances, have overlapping ranges so as to produce a joint emission range, as shown by figures 1 and 3. The arguments with respect to complementary colors, i.e. blends of colors so as to form a new color, is given little weight since this argument uses a definition of "complementary" which is not disclosed by the specification and different from that previously argued. The definition of "complementary" in the specification and previously argued is that the sum of wavelength make up the whole of the joint emission range, such as that in figure 3 of the reference. The arguments with respect to the principle of detecting an envelope of emission is given no weight since this is

not what is being claimed. The claims are to a composition and a document comprising the composition. Applicants have not shown that the claimed composition and document are different and unobvious from that taught. The rejections are maintained.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melissa Koslow whose telephone number is (571) 272-1371. The examiner can normally be reached on Monday-Friday from 8:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo, can be reached at (571) 272-1233.

The fax number for all official communications is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/cmk/  
January 13, 2010

/C. Melissa Koslow/  
Primary Examiner  
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